

REMARKS

As a preliminary matter, Applicants acknowledge that the pending Office Action is a final rejection. Because Applicants believe the finality of the rejection to be in error (see section I, below), the present amendment is respectfully submitted for entry.

Claims 25 and 34 are currently being amended, claims 29- 33 are canceled, and claims 50-67 are being added. Support for the amended and new claim language may be found throughout the application as originally filed. Support for the new claims in particular includes but is not limited to:

- Claim 50: Claims 1 and 2 as filed; p. 5, line 13 – p. 11, line 14; p. 23, line 4 – p. 33, line 6, particularly p. 33, line 5.
- Claim 51: Claims 1 and 2 as filed; p. 38, line 12 (Formula V); exemplified compounds, including but not limited to 336, 337, and 339.
- Claim 52: Claims 1 and 2 as filed; exemplified compounds, include but are not limited to 8.
- Claim 53: Claims 1 – 6 as filed; p. 29, line 30; p. 30, line 2; p. 33, line 6; p. 30, line 7 – p. 40, line 8; exemplified compounds, include but are not limited to 336.
- Claim 54: Claims 1 – 6 as filed; p. 29, line 30; p. 30, line 2; p. 33, line 6; p. 30, line 7 – p. 40, line 8; exemplified compounds, include but are not limited to 8.
- Claim 55: Claims 1 and 2 as filed; p. 5, line 13 – p. 11, line 14; p. 23, line 4 – p. 33, line 6, particularly p. 33, line 5.
- Claim 56: Claims 1 – 6 as filed; p. 29, line 30; p. 30, line 2; p. 33, line 6; p. 30, line 7 – p. 40, line 8; exemplified compounds, including but are not limited to 167.
- Claim 57: Claims 1 – 6 as filed; p. 29, line 30; p. 30, line 2; p. 33, line 6; p. 30, line 7 – p. 40, line 8; exemplified compounds, include but are not limited to 276 and 277.
- Claim 58: Claims 1 and 2 as filed; p. 5, line 13 – p. 11, line 14; p. 23, line 4 – p. 33, line 6, particularly p. 33, line 5.

- Claim 59: Claims 1 – 6 as filed; p. 29, line 30; p. 30, line 2; p. 33, line 6; p. 30, line 7 – p. 40, line 8.
- Claim 60: Claims 1 – 6 as filed; p. 29, line 30; p. 30, line 2; p. 33, line 6; p. 30, line 7 – p. 40, line 8.
- Claim 61: Claims 1 and 2 as filed; p. 5, line 13 – p. 11, line 14; p. 23, line 4 – p. 33, line 6, particularly p. 33, line 5.
- Claim 62: Claim 19 as filed; p. 55, lines 1 - 4.
- Claim 63: Claim 20 as filed; p. 55, lines 8-13; p. 55, line 22 – p. 58, line 20; p. 65, lines 20-28; Examples, p. 140 – p. 149.
- Claim 64: Claim 21 as filed; p. 54, lines 8-10, 16-18.
- Claim 65: Claim 22 as filed; p. 55, lines 5-17; p. 54, lines 8-10; p. 55, line 22 -2 p. 58, line 20.
- Claim 66: Claim 23 as filed; p. 55, lines 14-17.
- Claim 67: Claim 24 as filed; p. 55, lines 14-17; p. 55, line 22 – p. 58, line 20.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application is presented herein on pages 2-16, with an appropriate defined status identifier. After entry of the above amendment, claims 25-28 and 34-67 will be pending in this application.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

#### **I. Finality of the Office Action.**

Applicants respectfully submit that the finality of the outstanding Office Action is improper and respectfully request that the Examiner withdraw the finality of the rejection mailed on April 21, 2006. According to M.P.E.P. § 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new*

*ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement...Furthermore, a second or any subsequent action on the merits in any application...will not be made final if it includes a rejection, on newly cited art,...of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.*

(Emphasis added.) In the Office Action, the Examiner has cited new grounds of rejection of claims 25-49 based upon WO 97/05105; WO 97/42179; and WO 99/06340. None of these references are based on information submitted in an information disclosure statement. Nor are these new rejections necessitated by Applicants' amendment as, e.g., claims 25-33, 38 and 46 were not amended in Applicants' prior response. Indeed, the Examiner acknowledged that the previously cited 102 art was improper and has withdrawn rejections based on the previously cited art. As set forth above, "a second or any subsequent action...*will not be made final if it includes a rejection, on newly cited art,...of any claim not amended by applicant* in spite of the fact that other claims may have been amended to require newly cited art." (M.P.E.P. § 706.07(a), emphasis added.) Because the current rejection is based on newly cited art not previously of record, and was not necessitated by the Applicants' amendments, Applicants submit that a final rejection is not proper at this time in the prosecution of the instant application, and respectfully request that the Examiner withdraw the finality of the present Office Action.

## **II. Rejections under 35 U.S.C. § 102.**

Claims 25-49 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by a number of cited compounds, identified by registry number. The Examiner cites WO 97/05105 as teaching the species having registry numbers 188030-34-4 and 188030-36-6; WO 97/42179 as teaching the species having registry number 199484-15-6; and WO 99/06340 as teaching the species having registry numbers 220390-63-6 and 220390-64-7. Claims 29-33 have been canceled, rendering the rejection moot with respect to these claims. Applicants respectfully traverse the rejections as applied to the remaining claims.

Applicants respectfully submit that amendment of claim 25 renders the rejection based upon the above cited references moot. Claim 25 currently recites, in part, that “Y is selected from the group consisting of (1) substituted or unsubstituted C<sub>3</sub>-C<sub>8</sub>-cycloalkyl; (2) substituted heterocyclyl; and (3) substituted heteroaryl.” Because the compounds of the cited art have either a substituted or unsubstituted aryl or an unsubstituted heterocyclyl group at corresponding position Y in the compound of Formula IA, as recited in claim 25, Y does not encompass the cited compounds. As claims 26-28, 38, 40, 42, 44, and 46 all depend from claim 25, none of these claims can be anticipated by the cited compounds.

The Examiner has cited all claims 25-49 as being anticipated by the cited references. However, independent claims 34 and 35, from which claims 36, 37, 39, 41, 43, 45, 47, and 49 depend, all have a butadiyne group, while none of the cited compounds has a butadiyne group. Therefore, claims 34-37, 39, 41, 43, 45, 47, and 49 are not anticipated by the cited compounds.

In view of the amendment to claim 25 and the foregoing remarks, Applicants respectfully submit that claims 25-28 and 34-49 are not anticipated by the cited compounds, and request that the Examiner withdraw the rejection of claims 25-29 and 34-49 under 35 U.S.C. § 102(b).

### **III. Double Patenting Rejection.**

Claims 35-37 stand provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same subject matter as claims 9-11 of copending U.S. Application No. 11/289,658. As of June 20, 2006, no Office Action had yet issued with respect to this application. The rejection of claims 35-37 thus remains provisional.

Applicants respectfully submit that the procedure set forth in § 804(I)(B)(2) of the M.P.E.P. is applicable to the present provisional double-patenting rejection. Section § 804(I)(B)(2) of the M.P.E.P. requires that

[i]f a ‘provisional’ statutory double patenting rejection is the only rejection remaining in one of the applications (but not both), the examiner should withdraw the rejection in that application and

permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application into a double patenting rejection when the application issues as a patent.

Because Applicants believe that no other rejections remain in the present application, Applicants respectfully request that Examiner Davis withdraw the provisional double patenting rejection of claims 35-37 in the present application, based on claims 9-11 of U.S.S.N. 11/289,658, and allow this application to issue. Applicants make no admission regarding the propriety of the double patenting rejection in this application over U.S.S.N. 11/289,658 and specifically reserve the right to challenge the propriety of this rejection.

### CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

Should any issues remain to be resolved in view of the present amendment and remarks, the Examiner is invited to contact the undersigned by telephone to address such issues and conclude the prosecution of the present application.

Respectfully submitted,

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